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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/248,524 02/09/99 SHAH

A 2870/72

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EXAMINER

BERMAN, A

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

09/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application N .

09/248,524

Applicant(s)

SHAH, AMIT R.

Examiner

Alysia Berman

Art Unit

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
 2. ☐ received in Application No. (Series Code / Serial Number) ____.
 3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

1. Receipt is acknowledged of the amendment, information disclosure statement and change of address filed 19 June 2000. Claims 1, 5, 10, 14, 16, 18, 19 and 22 have been amended. Claims 1-22 are pending.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the post office address of each inventor. A post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The post office address should include the ZIP Code designation.

3. Applicant asserts that the declaration does contain a post office address because it lists the city, state and zip code of Applicant's residence in the box entitled "Post Office Address". A city, state and zip code would not suffice for a post office address. In any event, the box entitled "Post Office Address" is blank. Therefore, a new oath or declaration is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

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5. Claims 1-9, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 is indefinite because it recites "A long-wearing cosmetic composition a polymeric component..." It is unclear if the composition contains only those components recited or if it may contain additional components. Clarification is requested.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. For examination purposes, claim 1 has been treated as comprising the recited components.

9. Claims 1-4, 6-13, 15, 17 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,712,571 ('571).

This rejection is maintained for reasons of record.

10. Claims 1-7, 9-14 and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,874,072 ('072).

This rejection is maintained for reasons of record.

Response to Arguments

11. Applicant's arguments filed 19 June 2000 have been fully considered but they are not persuasive.
12. Applicant argues that the references do not disclose water-soluble organic pigments. US '571 discloses FD&C yellow 5 at column 2, line 35 as stated in paper no. 3. US '072 discloses D&C organic pigments at column 6, lines 21-30, all of which are water-soluble. Although the references also disclose water-insoluble lakes, they are not limited to such. All disclosures in a reference patent must be evaluated, including non-preferred embodiments. A reference is not limited to disclosure of the specific working examples. See *In re Mills* 176 USPQ 196 (CCPA 1972).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,874,072 ('072) in combination with US 4,761,277 ('277).

US '072 teaches all of the limitations as stated in paper no. 3 and is directed to eye makeup compositions (abstract). It does not teach a flow-through eyeliner pen having a nib. US '277 teaches that it is known in the art to apply eyeliner compositions using a flow-through nib pen (col. 1, lines 12-20). US '277 also teaches water-soluble organic pigments in cosmetic compositions (col. 1, lines 55).

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '072 in the form of an eyeliner in a flow-through pen having a nib as taught by US '277. The motivation to do so flows from the desire for ease of application of cosmetic compositions.

16. Claims 1-15, 17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,874,072 ('072) in combination with US 4,712,571 ('571).

US '072 and US '571 teach all the limitations of the claims as stated in paper no. 3. US '072 does not teach a flow-through cosmetic applicator. US '571 teaches a pen-like flow-through applicator at column 1, lines 62-63. US '571 does not teach ammonium acrylate as the polymeric component. US '072 teaches an ammonium acrylate copolymer at column 2, line 61 to column 3, line 1.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of either US '571 or US '072 in combination with the teachings of the

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other with the reasonable expectation of obtaining a film-forming, colored cosmetic composition. The motivation to combine the references flows from the desire for cosmetic compositions with improved wear and ease of application.

17. Claims 16, 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,874,072 ('072) in combination with US 4,712,571 ('571) as applied to claims 1-15, 17 and 19-21 above, and further in view of US 4,761,277 ('277).

US '072 and US '571 teach all the limitations of the claims as stated above. They do not teach an eye liner. US '277 teaches that it is known in the art to apply eyeliner compositions using a flow-through nib pen (col. 1, lines 12-20). US '277 also teaches water-soluble organic pigments in cosmetic compositions (col. 1, lines 55).

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '072 in combination with US '571 in a flow-through eyeliner pen having a nib as taught by US '277 with the reasonable expectation of obtaining a film-forming, colored cosmetic composition. The motivation to combine the references flows from the desire for cosmetic compositions with improved wear and ease of application.

18. It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). The idea of combining them flows logically from their having been individually taught in the prior art. *In re Crockett*, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (CCPA 1960).

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Response to Arguments


19. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.


Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703/308-4638. The examiner can normally be reached on Monday through Friday from 8:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703/308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703/305-3704 for regular communications and 703/305-3704 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-1234.


Alysia Berman
Patent Examiner
27 August, 2000


DIANA DUDASH
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